

RemarksRejections under 35 U.S.C. 101

Claim 9 has been amended to recite statutory subject matter.

Non-Art Rejections under 35 USC 112

The claims have been amended to eliminate multiple dependent claims.

The phrase “close-pored” has been amended to “closed-pore.” Despite the Examiner’s suggestion that the claims be amended “to recite a more conventional term,” the Examiner is respectfully reminded that Applicant is entitled to be his own lexicographer. Therefore unless the Examiner can provide a rationale for why Applicant’s choice of the word “pore” is indefinite, the Examiner is respectfully requested to withdraw the objection.

The word “obtainable” has been eliminated from the preamble of claim 1. Claim 1 now recites the reaction product of a specific process and reactants.

Withdrawal of these grounds of rejection is respectfully requested.

Art Based Rejections under 35 USC 103(a)

The claims have been amended to incorporate the limitation of Claim 7 into Claim 1 and all the claims depending therefrom. Curing of the foams produced by EP0751173 occurs at 140 °C and Applicant specifically notes in the specification that using the carbonate compounds of the ‘173 reference do not produce good foams because the higher curing temperature interferes with maintaining the foam. Applicant specifically notes that the blowing temperature (a temperature that facilitates the decomposition of the

carbonate blowing compound) and the curing temperature must be fairly close together, in contrast to the cited prior art. In arguing that the use of ammonium hydrogen carbonate as a blowing agent would have been obvious in view of the use sodium hydrogen carbonate and/or ammonium carbonate, the Examiner is using the impermissible obvious to try standard.

"The admonition that 'obvious to try' is not the standard under 35 U.S.C. 103 has been directed to two kinds of error. In some cases, what would have been obvious to try would have been to vary all parameters or to try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave no either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful. In others, what was obvious to try was to explore a new technology or approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it. For obviousness under [section] 103, all that is required is a reasonable expectation of success."

In re O'Farrell, 853 F.2d 894, 7 U.S.P.Q.2d 1673 (Fed. Cir. 1988).

The Examiner's comments about the expectations of success using ammonium hydrogen carbonate are grounded in prior art disclosures that disclose the use of carbonate compounds as blowing agents. The Examiner's remarks conveniently overlook the effect of decomposition temperature of the carbonate blowing agent on the instant process and on the foam produced thereby when the curing temperature is lowered as it is instantly to more closely match the blowing temperature. Both of these facts are important to the success of the instant process, not just the one discussed by the Examiner. Absent an understanding of the importance of the lower decomposition temperature of the specific claimed carbonate compound there can be no expectation of success.

Here Applicant has also demonstrated in the first two examples of the specification that the foams of the instant invention differ from the prior art foams of the '173 reference, the foams of the instant invention being

significantly more fire retardant. Thus, the process of the instant invention produces a different foam. Since the process produces a materially different product from the prior art, in at least one important aspect, fire retardance, Applicant is entitled to product-by-process claims. Withdrawal of all grounds of rejection under 35 U.S.C. 103 is respectfully requested.

Applicant respectfully submits that the instant amendment is now fully responsive to the Action mailed June 24, 2005 and the notice mailed December 8, 2005.

Accordingly a notice of allowance is respectfully solicited for Claims 1-6, and 8-9, the claims currently pending.

Respectfully submitted:



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